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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,762	01/04/2001	Jimmy Randolph Lewis	29488/36815	3783
4743 7590 03/01/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER SHAPIRO, JEFFERY A	
			ART UNIT 3653	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/754,762	Applicant(s) LEWIS ET AL.	
	Examiner Jeffrey A. Shapiro	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8, 10-19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 10-19 and 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>2/28/07</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Transitional After Final Practice

1. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on 1/31/07 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7, 8, 10-19 and 21-28 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Exhibits C and D, referred to in Applicants' 131 affidavit filed 9/5/06, provides evidence establishing public use/sale. Exhibit C concerns "Pick-To-Bucket" criteria. Exhibit D concerns a proposal for a "Pick-To-Bucket" order processing system, presented to Walgreen's Corp. Applicants' affidavit mentions on p.3, section 10, 2nd sentence, that Exhibit C was submitted before Exhibit D to SI Handling Systems. Exhibit D has a date of June 30, 1999, which is more than one year before the Applicants' filing date of 1/4/2001. Exhibit C therefore was submitted before this date.

Applicants also state regarding Exhibit C that a "pick-to-light system" is used to direct an operator to place items into a hopper indicated by a light. Exhibit D describes

directing a stock worker to transfer items from bins to containers based on prescribed pick operations (see "system description", p. 2), at least one number display, a container display, and a first indicator. A Computer is described at p.4, and p.5, referred to as an "SI-BRTS" controller. Note that p.4 illustrates a computer with display. P. 5 also describes order data the SI-BRTS controller receives. This includes information such as "tote box number", address 1-4, box flag, and source. All of these pieces of information can be construed as directional information. A second location indicator comprising a direction display can therefore be construed as the computer display of the SI-BRTS controller.

Regarding proof of sale, note the table of contents refers to sections 6-8, redacted, which concern "pricing", "schedule" and "standard terms and conditions". Further, a cover letter is included dated June 30, 1999 from Pete Marri at SI Systems to Sean McGonagle of Walgreens which states "[w]e are pleased to offer this proposal to design, build and commission a Pick-to-Bucket Order Selection System for Walgreens."

4. Claims 7, 8, 10-19 and 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Teicher et al (WO 98/00819). Note that the text of the '819 document is substantially that of Teicher's (US 6,205,396 B1) document. References in the rejection below are cited with respect to the '396 patent.

As described in **Claims 7, 13, 18, 23 and 24**, Teicher discloses at least one number display (22D, 24D, and 110) and a container display (24L). See also figure 2b. Teicher discloses a computer (11, 30). See also col. 2, lines 3, 4. Regarding a subsequent pick, note that once the current pick operation is completed, the operator

enters information regarding service completion, and the next or subsequent pick is then shown. See col. 3, line 60-col. 4, line 2. Also note that a "current pick" may contain several items to be picked from the same bin, in which case a subsequent pick would embody one of the several items from the same bin. Teicher further discloses displaying a direction indicator (22A, 22L, 22R), as illustrated in figures 1 and 2, which provides an operator with visual information in the form of an arrow that indicates the route to take to perform the next pick task.

As described in **Claims 11, 14, 22 and 25**, Teicher discloses the operator entering an "operation complete" information to indicate to the system that the current pick operation is complete. See again, col. 3, line 60-col. 4, line 2. The computer (20) then transmits new information. See col. 6, lines 20-30.

Regarding **Claims 10, 15, 21 and 26**, Teicher discloses a multi-purpose exception button in the form of operator interface (32) that enables the operator to indicate to the computer that a quantity of items is less than the number required. See col. 3, lines 60-64.

Regarding **Claims 8 and 19**, Teicher discloses a centrally located indicator and display (15), as illustrated in figures 1 and 2a.

As described in **Claim 12, 16 and 27**, bin indicators (16) are associated with particular storage bins. See figures 1 and 2b.

Regarding **Claims 17 and 28**, Teicher's computer directs operators to various locations based on various criterion, including order received, orders with problems that need to be reworked, etc. See col. 6, lines 20-41. Note also that Teicher's system

runs on orders received, and if a certain items are popular, operators will be directed to the locations of the most requested items by default.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 7, 8, 10-19 and 21-28 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Applicant argues that the 102(b) on-sale-bar rejection discussed above is negated by the fact that the communication between SI Handling Systems and Walgreens was confidential, and therefore not public per the “confidentiality agreement” at the bottom of each page of Exhibit D. This “agreement” states in part that “[t]he concepts and features of the design depicted herein is the property of SI Handling Systems, Inc...” This statement suggests that SI Handling Systems is infact that originator and/or owner of the designs discussed in Exhibit D.

Response to Amendment

7. The affidavit filed on 1/31/07 under 37 CFR 1.131 is sufficient to overcome the Teicher reference (US 6,205,396 B1).

Response to Arguments

8. Applicant's arguments with respect to Claims 7, 8, 10-19 and 21-28 have been considered but are moot in view of the new ground(s) of rejection. See above discussion.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAS

2/27/07



PATRICK MACKEY
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